

BOOK REVIEW

Ann Monotti with Sam Ricketson, *UNIVERSITIES AND INTELLECTUAL PROPERTY: OWNERSHIP AND EXPLOITATION* (Oxford University Press, 2003, RRP \$360.00); 626 + lxvii pp.

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Over recent years there has been considerable interest in the intersection between intellectual property rights and higher education. This interest is probably due in part to the increased attention that is being paid to intellectual property matters generally. There is, however, also a genuine sense that universities are in a unique position, being both high volume users of material protected by copyright and other forms of intellectual property and, at least potentially, owners of valuable rights over research and teaching material. Moreover, there is a real concern in some quarters that an emphasis on ownership and commercialisation of research is incompatible with the unique role that universities have in disseminating knowledge and encouraging the free flow of ideas. *Universities and Intellectual Property: Ownership and Exploitation* is therefore timely. As the authors explain in the preface, this book is the end result of a project started by Ann Monotti (now an Associate Professor at Monash University) in 1994, working here in conjunction with Professor Sam Ricketson, one of the world's leading intellectual property scholars. As is to be expected from such a collaboration, this is, in many respects, an impressive book.

Having set the scene, the authors begin their analysis in chapter 2 by analysing critically the nature and role of universities. Drawing on an impressive range of sources, the authors set out to show that the role of the university has evolved continuously and that some of the claims that are made for the special status of universities do not stand up to serious scrutiny. This chapter is the linchpin of the book, since much of the authors' analysis rests on the premise that while universities do play a distinctive and valuable role in modern societies, the onus is on those calling for universities and academics to be treated differently with regard to intellectual property matters to prove their case. One of Monotti and Ricketson's most significant achievements is maintaining this clear and consistent theme over more than 500 pages of detailed legal analysis.

The authors concentrate on three jurisdictions, namely, Australia, the United Kingdom and the United States. The ambitious aim is to provide a work that can be

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used as a practical guide to the law by those dealing with intellectual property issues in a university setting in all three jurisdictions. Chapters 3–9 of *Universities and Intellectual Property* are concerned with current law and practice. Beginning with a description of the basic features of different intellectual property rights in chapter 3, the authors consider the creation and ownership of intellectual property rights, specific challenges and issues faced by universities, and the ways in which research can be commercialised. The difficulty with any survey of the law in more than one jurisdiction is that it is hard to ensure accuracy, and mistakes have inevitably crept in here. For example, the discussion of film authorship in the UK is now out of date (page 184), as is the discussion of the ownership of films created in the course of employment (pages 185, 196).¹ Such mistakes are, however, remarkably few and far between. In the final section of the book, chapters 10–12, Monotti and Ricketson turn to consider future directions in the ownership and commercialisation of university owned research. These chapters include interesting discussions of how universities could minimise potential conflicts of interest and how universities might try to overcome other obstacles to commercialisation. The final chapter also does a good job of bringing together the book as a whole.

The authors are to be congratulated for having produced a book that is a successful blend of a practical guide to the law covering three jurisdictions and a scholarly monograph – no mean achievement. Mention must also be made of the range of material drawn upon by the authors. Monotti and Ricketson draw upon government documents, ministerial statements, university policies on intellectual property and empirical research into the attitudes of university staff, as well as more traditional sources, to make their case. *Universities and Intellectual Property* is therefore a valuable addition to books on intellectual property and criticisms of the book need to be seen against this background.

When viewed as a guide to the law, one element of *Universities and Intellectual Property* that is potentially frustrating is the introduction to intellectual property rights provided in chapter 3. Although it is clearly impossible for a book of this type to provide a detailed survey of all forms of intellectual property, there are some surprising omissions from this chapter and the treatment of some rights is too brief. For example, trade mark law only receives two brief paragraphs in which no mention is made of protection for unregistered marks, nor is there a reference to the relevant legislation in any of the three jurisdictions covered. This is despite the fact that the authors recognise both that universities are increasingly aware of the importance of marketing and protecting their 'brand', and that in the case of spin-off companies trade marks can be 'of great commercial value and significance to both the company and university' (page 82). Equally significant, at least for UK readers, is that the authors do not deal with the new copyright type rights introduced as a result of European harmonisation. Consequently, there is no discussion of the 'database right',² nor is there any mention of the 'publication right', that is, the right given to the first person to

1 The relevant changes to UK law came into effect on 1 December 1996.

2 See *Copyright and Rights in Databases Regulations 1997* (SI 1997/3032) (UK); *European Parliament and Council Directive (96/9/EC) of 11 March 1996 on the legal protection of databases* [1996] OJ L 77/20.

publish a previously unpublished work after the expiry of copyright.³ This is despite the fact that academics and university librarians frequently produce material that might attract database protection and that universities often have custodianship of unpublished works and papers. More generally, from a UK perspective, the authors' treatment of the European harmonisation of intellectual property rights is much too brief, the authors devoting a mere seven lines to this topic, despite its ever increasing importance.

There are also features of *Universities and Intellectual Property* that are likely to prove frustrating to a US audience. In particular, the level of detail provided in relation to the legal position in the US varies quite markedly between different sections. For example, while there is a detailed discussion of when a work will be classified as a 'work made for hire' under US law, including an analysis of many of the more important cases (pages 198–201), the law of trade secrets in the US only attracts a few lines of comment, the reader being referred instead to specialist texts on the subject (page 212). While the authors could not be expected to provide a detailed survey of every aspect of state and federal law that impacts upon university ownership of intellectual property, the book might have been more useful to an American audience if it provided a basic overall summary of the legal position, rather than dealing with some issues in detail and leaving other issues almost entirely unexplored. At the very least there should be some explanation of why particular issues merit detailed consideration. Non-specialist readers in the UK and the US may also be caused difficulty by the way legislation is cited in *Universities and Intellectual Property*. Whereas UK and US legislation is always cited as such (for example, the UK Patents Act is cited as the *Patents Act 1977* (UK)), Australian legislation is not treated in the same way. While it would soon become clear to a reader of the book as a whole that a reference to, say, the *Patents Act 1990* (Cth) must be to a piece of Australian legislation, it is easy to imagine a UK or American reader becoming confused when using *Universities and Intellectual Property* as a guide to dealing with a specific issue.

Readers attempting to use *Universities and Intellectual Property* as a practical guide are also likely to be frustrated by the index, which, surprisingly for a book published by Oxford University Press (OUP), is poor. To take but one example, it is impossible to use the index to locate the authors' discussion of fair dealing and fair use, since neither term appears in the index. Obvious alternatives, such as 'research and private study' do not appear either. The reader may, after some searching, find a discussion by looking up 'Copyright' – 'exceptions and limitations' but this merely refers the reader to a brief section in chapter 3, not to the other sections in which the authors discuss the role of the copyright exceptions. Evidence that the normally high production values of OUP have slipped somewhat is perhaps also to be found in the inconsistent way in which some material is cited. Most strikingly, articles in the *European Intellectual Property Review* are cited in at least five different ways, sometimes inconsistently within the same footnote (for example, page 157, footnote 109).

While none of the above criticisms should be seen as detracting from the authors' overall achievement, these are points of potential frustration that should be resolved prior to the publication of a second edition.

³ See *Copyright and Related Rights Regulations 1996* (SI 1996/2967) (UK) regs 16 and 17; *Council Directive (93/98/EEC) of 29 October 1993 harmonising the term of protection of copyright and certain related rights*, [1993] OJ L 290/9, Art 4.

Leaving aside the authors' treatment of the law and turning to the authors' argument and framework, the obvious criticisms lie not so much with the authors' conclusions, but more with their assumptions and starting points. For example, the authors do a good job of undermining some of the exaggerated claims that are made for the special status of academic work. Consistent with this analysis, the authors argue that 'academic authors must demonstrate why their circumstances are so different from those of other employees' (at page 494) and that 'the starting point with any model of IP ownership [in universities] must be the [ordinary] statutory and common law positions' (at page 516). The problem lies not in this conclusion per se, but rather in the unspoken assumption that the rules relating to employee creators generally in Australia, the UK and the US are appropriate. The conclusion that academics should not necessarily be in a more favourable position than other employees would look very different in, say, Germany, where all authors and inventors who create works or inventions in the course of their employment receive extensive protection. It is perhaps worth contrasting Monotti and Ricketson's approach with the recent report produced by the UK based Creators' Rights Alliance, *Between a Rock and a Hard Place*, which seeks to demonstrate 'that the current UK copyright regime leaves creators with little guarantee of continuing remuneration from the use of their works and little or no control over how their works are used or exploited; it fails adequately to protect the human rights of creators, to provide incentives to create, or to provide a fair reward to creators for their efforts'.⁴

Monotti and Ricketson's assumption that the general system for allocating rights between employers and employees is fair and appropriate, is tied up with their more general belief that current intellectual property laws represent 'a balance' between competing interests, a point they make throughout the book (for example, see pages 45, 546). But this account of the overall shape of intellectual property regimes is controversial. There are many commentators (including the reviewer) who believe that intellectual property laws have never been 'balanced' and that recent developments have made matters still worse. Not only will such commentators not share the authors' general confidence in the fairness of existing intellectual property regimes, they are also unlikely to share the authors' belief that many of the tensions that might arise between the commercialisation of research and the role of the university can be resolved through codes of practice and other voluntary arrangements.

Universities and Intellectual Property might also have engaged rather more directly with the views of those who are sceptical about the merits of universities seeking to commercialise their research. Only on the penultimate page of the book do the authors turn to consider 'whether it is ultimately worthwhile for a university to engage in commercialisation of its IP', noting that there are those who believe that 'everyone's dreams and hopes about this are far in excess of reality' (page 551). In defence of the authors it must be said that *Universities and Intellectual Property* does not attempt to push the commercialisation of university research. Rather, Monotti and Ricketson emphasise repeatedly that it is impossible to generalise across institutions, and that individual universities must design commercialisation strategies that are appropriate for their particular circumstances. However, a sceptic might object that many of the

⁴ See Creators' Rights Alliance, *Between a Rock and a Hard Place: The Problems Facing Freelance Creators in the UK Media Market-place* (2002) Creators' Rights Alliance <www.creatorsrights.org.uk/between_a_rock.htm> at 4 July 2002.

examples given by the authors focus on the success of a small number of research intensive universities and this is likely to reinforce the unrealistic expectations of those who are in favour of the push towards commercialisation. For example, when discussing how universities might overcome the difficulties they face in attracting seed funding, the authors focus on Oxford University's success in setting up a network of 'business angels' and in establishing a venture capital fund of more than £10 million (pages 429-430). Moreover, although the authors do not push the commercialisation of university research, they cite with approval the views of those who regard investment in commercialisation as a form of 'insurance policy' (page 551). While this is an entirely sensible view, it would have been nice to see some analysis of the likely cost of the 'premiums', in particular, for new universities that do not have a strong research profile.

In conclusion, it needs to be reiterated that, irrespective of the criticisms set out above, *Universities and Intellectual Property* is a good book that covers an impressive range of material. It will undoubtedly be extremely valuable to those involved in the design and implementation of university intellectual property policies. The authors have also made an important contribution to the debate about the operation of intellectual property laws on campus. Those who read the book will never look at the issues in quite the same way again, even if they disagree with certain aspects of the authors' approach.